

REMARKS

Claims 1-54 were pending in this application.

Claims 1-54 have been rejected.

Claims 1 and 6-54 have been amended as shown above.

Claims 1-54 remain pending in this application.

Reconsideration and full allowance of Claims 1-54 are respectfully requested.

I. OBJECTIONS TO THE DRAWINGS

The Office Action objects to the drawings because of various informalities. In particular, the Office Action asserts that several reference numerals (122a, 122b, 126, and 128) mentioned in the specification are not included in the drawings. The Office Action also asserts that several reference numerals (1002, 1004, and 1006) included in the drawings are not mentioned in the specification.

The Applicants have amended the specification to remove the references to numerals 122a, 122b, 126, and 128. The Applicants also respectfully note that reference numerals 1002, 1004, and 1006 are used in the specification on page 4, line 21 through page 5, line 14.

For these reasons, the Applicants respectfully request withdrawal of the objections to the drawings.

II. OBJECTIONS TO THE SPECIFICATION

The Office Action objects to the specification because of various informalities. The

Applicants have amended the specification to correct these informalities. As a result, the Applicants respectfully request withdrawal of the objections to the specification.

III. OBJECTIONS TO THE CLAIMS

The Office Action objects to the claims because of various informalities. The Applicants have amended the claims to correct many of the noted informalities. However, the Applicants respectfully note that Claims 12, 30, and 48 are proper dependent claims. For these reasons, the Applicants respectfully request withdrawal of the objections to the claims.

IV. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1-8, 10-14, and 16-18 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,072,807 to Daudelin (“*Daudelin*”). The Applicants respectfully traverse this rejection.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

Daudelin recites a technique for searching for signals to be assigned to fingers in a rake receiver. (*Abstract*). Each finger of the receiver is in one of multiple states (inactive, assigned, or

reserved). (*Col. 4, Lines 54-59*). The signal quality of the signal being received by a finger is used to place the finger in the appropriate state. For example, a finger in the reserved state is changed to the assigned state if the signal quality exceeds a “re-establishment threshold.” (*Col. 6, Lines 44-49*). Also, a finger is placed in the inactive state if the signal quality falls below a “de-assignment threshold.” (*Col. 7, Lines 2-9*).

Daudelin simply recites that a signal may be assigned and used when the signal quality exceeds a threshold. *Daudelin* also recites that a signal may be de-assigned and not used when the signal quality fails to meet another threshold.

In contrast, Claim 1 recites that different thresholds (SNR and signal-strength thresholds) are used to make different determinations. In particular, Claim 1 recites that a multipath signal is evaluated for categorization into a state using “at least one SNR threshold.” Claim 1 also recites that a determination is made as to whether the signal should be combined and/or deassigned using a “first signal-strength threshold” and a “second signal-strength threshold.”

Daudelin fails to anticipate these elements of Claim 1. In particular, *Daudelin* fails to anticipate categorizing a signal using one or more “SNR thresholds” and then choosing to combine or deassign the categorized signal using multiple “signal-strength thresholds.” As a result, *Daudelin* fails to anticipate all elements of Claim 1 (and its dependent claims).

Accordingly, the Applicants respectfully request withdrawal of the § 102 rejection and full allowance of Claims 1-8, 10-14, and 16-18.

V. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 9 and 15 under 35 U.S.C. § 103(a) as being unpatentable over *Daudelin*. The Office Action rejects Claims 19-54 under 35 U.S.C. § 103(a) as being unpatentable over *Daudelin* in view of U.S. Patent No. 5,852,630 to Langberg et al. (“*Langberg*”). The Applicants respectfully traverse these rejections.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of

obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP* § 2142).

Claims 9 and 15 depend from Claim 1. As described above in Section IV, Claim 1 is patentable. As a result, Claims 9 and 15 are patentable due to their dependence from an allowable base claim.

Claims 19 and 37 recite elements that are analogous to the elements recited in Claim 1. As described above in Section IV, *Daudelin* fails to disclose, teach, or suggest various elements of Claim 1 (and thus the analogous elements of Claims 19 and 37). *Langberg* is not cited by the Office Action as disclosing, teaching, or suggesting these elements of Claims 19 and 37. As a result, Claims 19 and 37 (and their dependent claims) are patentable over the proposed *Daudelin-Langberg* combination.

Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 9, 15, and 19-54.

VI. CONCLUSION

The Applicants respectfully assert that all pending claims in the application are in

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condition for allowance and respectfully request an early allowance of such claims.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: _____

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